

## Remarks/Argument

### Information Disclosure Statement

Applicants note that the Examiner has not considered references 73 and 74. These references are different editions of the ubiquitous Sambrook et al. manual on molecular cloning. As noted in the Information Disclosure Statement filed July 9, 2003 (which was received by the USPTO on July 14, 2003), copies of these references will not be forwarded to the USPTO since they are believed to be too voluminous, and in any case are likely easily obtained by the Examiner. In any case, references 73 and 74 can be considered as background material to the instant application.

### Claim rejection

Claims 2 and 3 are pending in the application. Claim 3 is allowed, and claim 2 is rejected under 35 USC 102(e) as allegedly anticipated by WO 01/94566 of Lexicon Genetics, Inc. Applicants respectfully traverse the rejection of claim 2, and request reconsideration of this claim.

35 USC 102(e) states in pertinent part that (emphasis added):

an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application *designated the United States* and was published under Article 21(2) of such treaty in the English language[.]

The Examiner asserts that WO 01/94566 falls within 102(e), and is therefore a competent reference against the instant application, because the serial number for WO 01/94566 is PCT/US01/26687. Apparently, the Examiner believes that, because WO 01/94566 was filed in the US receiving office under the PCT, that WO 01/94566 therefore designates the United States.

However, an international application can be filed in the US receiving office without designating the United States. Here, an inspection of the face page of WO 01/94566 shows that the United States was indeed *not* a designated state, even though the application was filed in the US receiving office. A copy of the face page of WO

01/94566 in enclosed, with an underscore in section (81) "Designated States" showing that the designation "US" is absent from the alphabetical listing of designated states.

This comports with the enclosed "Family Legal Status" printout obtained from the Delphion electronic database entry for WO 01/94566. Again, underscores are provided on the second page of this printout, showing that that the designation "US" is absent from the alphabetical listing of designated states.

Thus, WO 01/94566 is *not* a competent reference against the instant application under 25 USC 102(e), because it did *not* designate the United States. Applicants respectfully request that the rejection of claim 2 over WO 01/94566 be withdrawn.

#### Conclusion

Based on the foregoing, all pending claims are believed in condition for allowance. An early and favorable action toward that end is earnestly solicited.

Respectfully submitted,

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(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

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(10) International Publication Number  
**WO 01/94566 A2**

- (51) International Patent Classification<sup>7</sup>: **C12N 9/00** Woodlands, TX 77382 (US). **SANDS, Arthur, T.**; 163 Bristol Bend Circle, The Woodlands, TX 77382 (US).
- (21) International Application Number: **PCT/US01/26687**
- (22) International Filing Date: 25 January 2001 (25.01.2001)
- (25) Filing Language: English
- (26) Publication Language: English
- (30) Priority Data:  
60/179,000 28 January 2000 (28.01.2000) US
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- (74) Agents: **ISHIMOTO, Lance, K.** et al.; LEXICON GENETICS INCORPORATED, 4000 Research Forest Drive, The Woodlands, TX 77381 (US).
- (81) Designated States (*national*): AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CR, CU, CZ, DE, DK, DM, DZ, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NO, NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, TZ, UA, UG, UZ, VN, YU, ZA, ZW.
- (84) Designated States (*regional*): ARIPO patent (GH, GM, KE, LS, MW, MZ, SD, SL, SZ, TZ, UG, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE, TR), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GW, ML, MR, NE, SN, TD, TG).
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— without international search report and to be republished upon receipt of that report
- For two-letter codes and other abbreviations, refer to the "Guidance Notes on Codes and Abbreviations" appearing at the beginning of each regular issue of the PCT Gazette.*

\*US  
not  
designated



WO 01/94566 A2

(54) Title: NOVEL HUMAN ENZYMES AND POLYNUCLEOTIDES ENCODING THE SAME

(57) Abstract: Novel human polynucleotide and polypeptide sequences are disclosed that can be used in therapeutic, diagnostic, and pharmacogenomic applications.

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 Title: **WO0194566A2: NOVEL HUMAN ENZYMES AND POLYNUCLEOTIDES ENCODING THE SAME**[French]

 Derwent Title: Novel polynucleotides encoding novel human proteins sharing sequence similarity with nitrilase proteins, useful for generating primers, and probes which are used in identification of targets for drug discovery [[Derwent Record](#)]


 Country: **WO** World Intellectual Property Organization (WIPO)  
 Kind: **A2** Publ. of the Int. Appl. without Int. search REP. i (See also: [WO0194566A3](#) )

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[News, Profiles, Stocks and More about this company](#)


 Published / Filed: **2001-12-13 / 2001-01-25**


 Application Number: **WO2001US0026687**

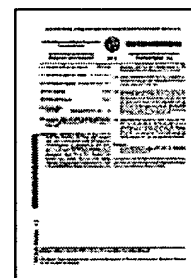
 IPC Code: **C12N 9/00**;

 ECLA Code: **C12N9/78**;

 Priority Number: **2000-01-28 US2000000179000P**

 Abstract: Novel human polynucleotide and polypeptide sequences are disclosed that can be used in therapeutic, diagnostic, and pharmacogenomic applications. [French]

 Attorney, Agent or Firm: **ISHIMOTO, Lance, K.** ; LEXICON GENETICS INCORPORATED, 4000 Research Forest Drive, The Woodlands, TX 77381 United States of America



High Resolution

Low Resolution

36 pages

*for legal status see second page.*



INPADOC  
Legal Status:

Gazette date	Code	Description (remarks) List all possible codes for WO
2002-08-28	NENP	Non-entry into the national phase in: ( RU )
2002-08-28	NENP	Non-entry into the national phase in: ( RU )
2002-07-11	ENP	Entry into the national phase in: (JP XX0000000502108 )
2002-05-23	REG DE 8642	Reference to national code Impact abolished for de - i.e. pct appl. not ent. german phase
2002-05-02	DFPE	Request for preliminary examination filed prior to expiration of 19th month from priority date
2002-02-06	121	EP: the epo has been informed by wipo that ep was designated in this application
2001-12-13	AK +	Designated states cited in a published application without search report (AE AG AL AM AT AU AZ BA BB BG BR BY BZ CA CH CN CR CU CZ DE DK DM DZ EE ES FI GB GD GE GH GM HR HU ID IL IN IS JP KE KG KP KR KZ LC LK LR LS LT LU LV MA MD MG MK MN MW MX MZ NO NZ PL PT RO RU SD SE SG SI SK SL TJ TM TR TT TZ <u>UA UG UZ</u> VN YU ZA ZW )
2001-12-13	AL +	Designated countries for regional patents cited in a published application without search report (GH GM KE LS MW MZ SD SL SZ TZ UG ZW AM AZ BY KG KZ MD RU TJ TM AT BE CH CY DE DK ES FI FR GB GR IE IT LU MC NL PT SE TR BF BJ CF CG CI CM GA GN GW ML MR NE SN TD TG )

\* US not designated

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Designated Country: AE AG AL AM AT AU AZ BA BB BG BR BY BZ CA CH CN CR CU CZ DE DK DM DZ EE ES FI GB GD GE GH GM HR HU ID IL IN IS JP KE KG KP KR KZ LC LK LR LS LT LU LV MA MD MG MK MN MW MX MZ NO NZ PL PT RO RU SD SE SG SI SK SL TJ TM TR TT TZ UA UG UZ VN YU ZA ZW, **European patent:** AT BE CH CY DE DK ES FI FR GB GR IE IT LU MC NL PT SE TR, **OAPI patent:** BF BJ CF CG CI CM GA GN GW ML MR NE SN TD TG, **ARIPO patent:** GH GM KE LS MW MZ SD SL SZ TZ UG ZW, **Eurasian patent:** AM AZ BY KG KZ MD RU TJ TM

\* US not designated

Family: Show 6 known family members

Description: Expand full description

+ NOVEL HUMAN ENZYMES AND POLYNUCLEOTIDES ENCODING THE SAME  
+ BACKGROUND OF THE INVENTION  
+ SUMMARY OF THE INVENTION  
+ DESCRIPTION  
+ DETAILED DESCRIPTION OF THE INVENTION

First Claim: Show all claims 1. An isolated nucleic acid molecule comprising at least 24 contiguous bases of nucleotide sequence first disclosed in SEQ ID NO: 1. †

Other Abstract Info: CHEMABS 136(04)050280P CHEMABS 136(04)050280P DERABS C2002-519061 DERABS C2002-519061



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